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07/303, 747 01/30/89 FAHIM

M 91221

EXAMINER

HENLEY III, R

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| ART UNIT | PAPER NUMBER |
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125

DATE MAILED:

12/04/90

Check one box to indicate the examiner in charge of your application  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on 10/15/90  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.  
2.  Notice re Patent Drawing, PTO-948.  
3.  Notice of Art Cited by Applicant, PTO-1449.  
4.  Notice of Informal Patent Application, Form PTO-152  
5.  Information on How to Effect Drawing Changes, PTO-1474.  
6.

Part II SUMMARY OF ACTION

1.  Claims 1-29 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 1-29 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved;  disapproved (see explanation).

12.  Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

EXAMINER'S ACTION

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Claims 1-29 are presented for examination.

Claims 1-4, 6, 8-13, 19-23 and 25-26 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited in accordance with the disclosure at pages 1-14 of the specification. See M.P.E.P. §§ 706.03(n) and 706.03(z).

In further explanation:

(1) The expressions "mineral salt of a carboxylic acid" and "a carboxylic acid derivative of a pentose or hexose" (claims 1, 10, 19 and 23) are unwarranted as to their breadth by the limited disclosure at pages 1-3 of the specification;

(2) Claims 8-13 and 25-26 are unduly broad in that no amounts or relative proportions of amino acids to employ are set forth therein (claims 8-10 and 25-26) and the term "an amino acid" appears unduly broad in view of the limited disclosure at page 3, lines 22-31, especially lines 28-29.

Claims 1-18 and 25-26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In further explanation:

(1) In claims 1, 10 and 15 the expressions "by applying" and "by injecting" impart an indefinite scope thereto. It is suggested that a term such as "comprising", "which comprises"

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"consisting essentially of", "which consists essentially of", "consists of" or "which consists of" be employed in the place of "by" so as to overcome this point of the rejection;

(2) Claims 10 and 15 appear indefinite since they fail to recite any one particular method step which would accomplish the intended result; the mere recitation of the verbs "injecting" and "applying" are insufficient to point out either the site or host intended;

(3) In claim 15, the "calcium acetate" ingredient appears inconsistent with the indicated Markush grouping; and

(4) In claim 25, the word "comprises" should replace the indefinite term "includes" which appears at line 2, the second word; and

(5) Claims 8-10 and 25-26 appear indefinite in that no amounts or relative proportions of amino acids employed have been set forth thereby failing to adequately set forth the metes and bounds of the subject matter for which applicant is seeking patent protection. The use of either actual weight amounts or appropriate functional language to modify the term "amino acid" is suggested to overcome this point of the rejection.

Claim 8 is rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

There is not a provision for adding a second active

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ingredient in the claim from which claim 8 depends.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-7 and 15-24 are rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Fahim '428, Aonuma et al. and Rosado et al.

Each reference teaches the use of zinc and salts thereof in various concentrations effectively inhibits the motility and viability of spermatozoa. Note all of Aonuma et al. and Rosado et al. and Fahim et al the abstract, column 3, lines 54-56 and column 4, lines 1-7.

The difference between the above teaching and applicants' claimed subject matter lies in that (1) applicants' concentrations are not highlighted; and (2) zinc gluconate as a zinc salt is not highlighted. However, to the skilled artisan,

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it would have been obvious to reconcile these differences and said artisan would have been motivated to do so since (1) the determination of optimum amounts of ingredients to employ is conventional and thus well within the skill of the art; and (2) zinc gluconate is a well known zinc salt having physiological utility and thus its selection would have been merely a matter of obvious alternatives.

Claims 8-14 and 25-29 are rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Fahim '438, Aonuma et al. and Rosado et al as applied to claims 1-7 and 15-24 above, and further in view of European Patent No. 1322821 (Ohashi et al.).

The difference between the subject matter of the instant claims and Fahim '438, Aonuma et al. and Rosada et al. lies in that the inclusion of an amino acid component with the zinc salt is not highlighted in the prior art.

However, to the skilled artisan, it would have been obvious to reconcile this difference and said artisan would have been motivated to do so since neutral amino acids have been disclosed as being capable of adjusting an aqueous pharmaceutical solution to a physiological pH (page 9 of Ohashi et al., lines 3+) and Fahim teaches that a physiological pH is desirable for zinc compositions of the type claimed. The determination of the optimum amounts of amino acids to employ is considered to be well

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within the skill of the art.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23-29 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Godfrey. The reference teaches a composition which comprises a zinc salt of the type claimed (column 1, lines 47-55) and amino acids (column 1, lines 30-35) in an aqueous solution.

The difference between the above teaching and applicants' claimed subject matter lies in applicants' use of functional limitations not taught in the reference and applicants amounts and/or proportions are not highlighted.

However, insofar as the recitation of the intended use of the prior art composition fails to patentably distinguish the claimed composition from the prior art, the difference need not be resolved. The determination of optimum amounts is well within the skill in the art.

Claims 19-22 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Eby.

The reference teaches zinc salts of the type claimed as

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useful in aqueous compositions. Note column 3, lines 29-51.

The difference between the above teaching and applicants claimed subject matter lies in applicants' recitation of an intended use of zinc in an aqueous carrier, and applicants' amounts are not highlighted.

However, insofar as the functional language does not patentably distinguish applicants' composition from that of the prior art, this difference need not be reconciled. The determination of the optimum amounts of ingredients to employ is considered to be conventional and thus well within the skill of the art.

None of the claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ray Henley whose telephone number is (703) 308-3531.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

RAYMOND J. HENLEY III  
PRIMARY EXAMINER  
GROUP 120 - ART UNIT 125

Henley:st  
December 03, 1990

RAYMOND J. HENLEY III  
Primary Examiner  
Group Art Unit 125